

**REMARKS**

This is in response to the Office action dated January 5, 2006, in which claims 15 and 18 were rejected under 35 U.S.C. 112; claims 2, 4, 8, 11, and 12 were objected to based on informalities; claims 2, 11-13, and 15-19 were rejected under 35 U.S.C. 103(a); claims 3-10 were objected to as based on rejected base claims but indicated to be allowable; and the applicant's arguments for the allowability of all pending claims over the previous grounds for rejection were indicated to be persuasive and to have prompted the withdrawal of the previous grounds for rejection. The applicant is appreciative of the withdrawal of the previous grounds for rejection and of the indication of allowable subject matter.

The applicant has amended claims 2, 4, 8, 11, 12, 15, and 18 to resolve the formality objections and the §112 rejections, and amended claim 16 to make a trivial correction. The applicant believes that these amendments place the pending claims in condition for allowance. The applicant thereby respectfully requests that the rejection of claims 2, 11-13, and 15-19 be withdrawn and that claims 2-13 and 15-19 be allowed in light of the amendments and remarks herein.

**KING, PEJCHAR, AND CASE LAW DO NOT RENDER CLAIM 2 OBVIOUS**

Claims 2 and 15 were rejected under §103 based on King and Pejchar in further view of case law, after the previous rejections of claims 2 and 15 based on King and Pejchar were withdrawn. In particular, while the Office conceded the presence of distinctive differences between claim 2 and the combined references, the Office characterized the differences as a matter of art recognized equivalence and as a mere change in size. As the Office aptly pointed out, the Court of Appeals for the Federal Circuit has held that a claimed device is not patentable where the only differences between the prior art and the claims

was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device (emphasis in Office action). However, precisely this distinction shows that claim 2 is indeed non-obvious and patentable over the cited references.

In particular, claim 2 does not define a mere change in relative dimensions of the aperture relative to King. Rather, claim 2 includes a change in functionality and performance. For example, making the aperture of size to admit part of the basket allows the basket shape rather than just the pin to fit into the aperture, thereby inhibiting rotation of the basket. A device of claim 2 therefore performs differently than the prior art devices, and is not taught or suggested by the cited references, alone or in combination.

The Office also asserted that the references indicated that an art recognized equivalence would have motivated a person of ordinary skill in the art to combine elements of the two references. However, any indication of art recognized equivalence must be contrasted against the contradictory fact, explained in the applicant's previous response and uncontested in the Office action, that Pejchar explicitly teaches away from King.

In particular, Pejchar specifically teaches that the links of the drop chain e' serve the specific purpose of enabling different links inserted through the post a to effectuate different lengths for the drop e (column 2, lines 37-39). As another particular example, Pejchar teaches that the separate drop e is enabled to be attached to the post a with or without the intermediate member d. Pejchar teaches that it is the large variety of different combinations enabled by these features that provide its inventive advantages; but that variety of combinations is substantially diminished by substituting the subject matter of King, wherein the intermediary connecting member (26) includes a portion (28) for flexibly supporting the dangling element (32), as in the Office action. Therefore, to

combine the references as suggested by the examiner would clearly contravene the specific teachings of Pejchar, destroying what Pejchar teaches to be the desired versatility indicated to be a fundamental advantage of inserting the post a through links of the drop e.

While demonstrating objective evidence for a motivation to combine references is a required threshold for asserting obviousness, it is also improper to combine references that teach away from their combination. *In re Grasselli*, 218 USPQ 769, 779 (Fed. Cir. 1983). Therefore, the question of whether objective evidence demonstrates a motivation to combine the references is rendered moot by the conclusive factor that an invention is not shown to be obvious if its various elements are only identified in references that teach away from their combination.

Claim 2 also features many surprising and distinctive advantages over King and Pejchar as detailed in the applicant's previous responses, which are incorporated by reference herein. Therefore, due at least to the illustrative reasons outlined herein, the applicant respectfully submits that claim 2 is therefore not rendered obvious by the cited references.

**KING, PEJCHAR, AND CASE LAW DO NOT RENDER CLAIM 15 OBVIOUS**

Similarly, claim 15 includes wherein the intermediary connecting member engages the wires such as to inhibit rotation of the conical basket. This result is not obvious from the cited references because it would involve a change in function and performance from anything disclosed in any of the references, rather than a mere change in size of something without performing differently.

Furthermore, while the Office indicated that having the intermediary connecting member between the conical basket and the ear might help inhibit rotation of the intermediary connecting member relative to the conical basket, this presents a further disadvantageous feature of the cited references in that the

intermediary member would pinch the ear and likely be uncomfortable, as the applicant pointed out previously. The subject matter of claim 15 inhibits rotation of the conical basket without having to pinch the ear and cause discomfort in the attempt, another advantageous feature not disclosed or suggested in the references, alone or in combination.

Claim 15 also features many surprising and distinctive advantages over King and Pejchar as detailed in the applicant's previous responses, which are incorporated by reference herein. Furthermore, as discussed above with reference to claim 2, a combination of elements from King and Pejchar does not speak to the question of obviousness because King and Pejchar teach away from each other, a conclusive barrier to demonstrating obviousness that was pointed out by the applicant earlier and not contested in the previous Office action. Therefore, due at least to the illustrative reasons outlined herein, the applicant respectfully submits that claim 15 is not rendered obvious due to the cited references.

**KING AND SIMPSON DO NOT RENDER CLAIM 11 OBVIOUS**

Claim 11 was rejected under §103 due to the combination of King and Simpson. This is based on King being characterized as teaching a removable intermediary connecting member which removably, conformingly engages an exterior surface of the support wire, and on the purported motivation of a person of ordinary skill in the art to combine the bezel and support wires of Simpson with the basket of King due to an alleged art recognized equivalence between different heads.

However, King does not teach a removable intermediary connecting member which removably, conformingly engages an exterior surface of the support wire; nor is it shown or alleged in the Office action that such elements might be taught or suggested by a combination with Simpson. Rather, the intermediary member of King is disclosed to have a smooth, featureless bowl

shape, with no discernable features that even suggest that it might removably, conformingly engage an exterior surface of the support wire. Even assuming *arguendo* that the combination of King and Simpson suggested adding bezel and support wires to King, there is nothing to demonstrate that such a combination might suggest a removable intermediary connecting member which removably, conformingly engages an exterior surface of the support wire.

Therefore, due at least to this illustrative example of an element not disclosed or suggested by the references, the applicant respectfully submits that claim 11 is not rendered obvious by the cited references.

**KING AND SIMPSON DO NOT RENDER CLAIMS 12 AND 13 OBVIOUS**

Claims 12 and 13 were rejected under §103 due to King combined with Simpson. However, the applicant respectfully submits that this rejection was based on an overbroad characterization of the disclosure of these references, and requests that the Office reevaluate this rejection accordingly.

Claims 12 and 13 were previously rejected due to King and Simpson. The argument against that rejection was indicated to be persuasive, and a different argument based on King and Simpson was used to reject claims 12 and 13. However, the previous argument that was indicated as persuasive has not been addressed and still shows that the cited references do not demonstrate obviousness for claims 12 and 13.

Specifically, neither King or Simpson discloses or suggests elements of claim 12 such as a notch formed therein at points where the intermediary connecting member engages the support wire. Claim 12 is directed to an inventive jewelry design that includes, in part, wherein the intermediary connecting member has a notch formed therein at points where the intermediary connecting member engages the support wire. This is quite different from what is disclosed or suggested by King and

Simpson, and has not been shown to be disclosed or suggested by the references in the present Office action. Rather, King is inaccurately characterized in the Office action, in alleging that the intermediary member has a "notch (27)" formed therein at points where the intermediary connecting member engages a support wire (emphasis mine), where elements including the support wire are taken by combination with Simpson. However, element 27 of King is described as the "central passage" that "is slid onto post 13" (e.g. King col. 3 line 40). A central passage is not a "notch". The central passage of King is not consistent with the notch of claim 12 and therefore could not anticipate or suggest the notch element of claim 12, because the central passage of King is located at a single point, not at plural "points". Even if King is combined with Simpson, Simpson also does not disclose or suggest a notch formed at points where the intermediary connecting member engages the support wire.

While the Office action discusses other purported similarities, those are moot when the references are not shown to disclose or suggest all the elements of claim 12, as is the case here. Claim 13 is also believed to be separately allowable in addition to its dependence on claim 12.

Therefore, due at least to the illustrative reasons outlined herein, the applicant respectfully submits that claims 12 and 13 are not rendered obvious by the cited references.

**KING AND CASE LAW DO NOT RENDER CLAIMS 16-19 OBVIOUS**

Claims 16-19 were rejected under §103 due to King combined with case law. The Office asserts that King does not disclose the center of the aperture of the intermediary connecting member being of size to allow a portion of the conical basket to also extend therethrough, but that case law shows that patentable non-obviousness is not found if the only difference between the claimed device and the references is a different set

of relative dimensions, if the claimed device would not perform differently than the prior art device (emphasis in Office action).

However, as discussed above with reference to claim 2, claim 16 exhibits differences from the cited reference that go substantially beyond a mere change in relative dimensions, and that do in fact result in performing differently than a device of the reference. And as discussed above with reference to claim 2, the purported substitution of a wearer's ear for elements of the claimed invention does not show obviousness, but instead furthers the showing of the non-obviousness of the claim, because the substitution of the wearer's ear to try to achieve the substantially distinct functionality of the claim is structurally very different, and of questionable and marginal effectiveness at actually inhibiting rotation relative to the structure of the claim. Furthermore, the reliance on the wearer's ear to imitate the function of the claimed invention would necessarily involve the discomfort and pain of a metal chain being pressed against the wearer's earlobe for as long as the earring is worn, a grave disadvantage which is neatly resolved by the claimed invention.

Claim 16 therefore discloses subject matter with surprising and distinct advantages over the cited reference, beyond the subject matter of the cited reference by a considerably greater margin than anything the courts envisioned to be within the stretch of common knowledge in the art unsupported by objective references.

Therefore, due at least to the illustrative reasons outlined herein, the applicant respectfully submits that the cited reference, whether or not combined with case law, does not render claim 16 obvious. The applicant respectfully submits that claims 17-19 are also not rendered obvious by the cited reference, due at least to their dependency on claim 16.

**CLAIMS 3-10 COMPLY WITH INDICATED ALLOWABILITY**

Claims 3-10 were asserted to be objected to for depending on rejected base claims, and indicated as allowable if rewritten in a form independent of the rejected claims. The applicant has already made such an amendment in the previous response. The applicant therefore takes the understanding that, with corrections to resolve the formality objections to claims 4 and 8, claims 3-10 are presently in proper form for allowance.

**CLAIMS 2-13 AND 15-19 ARE IN CONDITION FOR ALLOWANCE**

The applicant therefore respectfully submits that claims 2, 11-13 and 15-19 are not shown to be obvious due to the references, and that this is reflective of the genuinely inventive and patentable nature of the subject matter of these claims. The applicant accordingly requests that the examiner withdraw the rejection of these claims, again, and allow claims 2, 11-13 and 15-19 along with claims 3-10.

An extension of time is hereby requested for responding to the Office Action. A charge authorization for the extension of time fee is included herewith.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,  
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